No. 87-2001

MAY 9 1988
JOSEPH F. SPANIOL, JR.
CLERK

IN THE SUPREME COURT OF THE UNITED STATES

May Term, 1988

IN RE RICHARD E. SCHIFFERLY

Petitioner,

vs.

COMMISSIONER OF PATENTS

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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QUESTIONS PRESENTED

1. The Commissioner of Patents (as to the subject case) is erroneously utilizing appearance (as opposed to a structural standard) or solely a functional standard as a basis for rejecting an application for a patent for an invention before the United States Patent Office pursuant to the provisions of 35 United States Code Sections 102 and 103.

2. The Commissioner of Patents has no authority to reject claims set forth in a patent application under the theory or doctrine of a provisional "obviousness-type" double patenting concept, as such a rejection is based on supposition or conjecture.

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COMMISSIONER OF PATENTS

Respondent.

PETITION FOR WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS FOR
THE FEDERAL COURT

The petitioner, Richard E. Schifferly, respectfully prays that a writ of certiorari issue to review the judgment and opinion of the judgment and opinion of the United States Court of Appeals for The Federal Circuit, entered in the above entitled proceeding on February 9, 1988.

OPINION BELOW

The opinion of the Court of Appeals for the Federal Circuit is not reported but is set forth in the appendix hereto as Part B. The decision of the United States Patent Office Board of Appeals is set forth in the appendix as Part C.

JURISDICTION

Petitioner brought the appeal herein to the United States Court of Appeals for the Federal Circuit (from the judgment and decision dated February 9, 1988) pursuant to 28 U.S.C. section 1254, etc.)

LIST OF PARTIES

Petitioner: Richard E. Schifferly

Respondent: Commissioner of Patents

STATUTES INVOLVED

35 U.S.C. Section 103; 35 U.S.C. Section 102(2), (b), (c), (d), and (e).

STATEMENT OF THE CASE

On October 15, 1981, Petitioner filed an application for a patent on a tire mounting tool, said application being designated serial number 247,281 by the United States Patent Office. The subject application was filed as a continuation in part of applicant's Patent Application serial number 110,556 filed on January 8, 1980 (which was subsequently abandoned), which latter patent applicant was a division of serial number 2,030, being filed on January 8, 1979. The latter patent application matured into patent number 4,262,727 entitled AUTOMATIC TIRE MOUNTING AND DEMOUNTING MACHINE ROLLER. This latter patent is not at issue herein.

The Commissioner of Patents rejected Appellant's application serial number 247, 281 and Petitioner filed an appeal with the Patent Office Board of Patent Appeals,

and the latter Board upheld the examiner in rejecting Appellant's application. A request for reconsideration was filed by the Appellant before the Board of Patent Appeals, and the Board of Patent Appeals affirmed its decision in denying Appellant's request for reconsideration. The Patent Office Board of Appeals upheld the examiner on the questions of non-obviousness (i.e. Applicant's invention not constituting an inventive step over the prior art under the parameters of 35 U.S.C. Section 103.) Another aspect addressed by the Patent Office Board of Patent Appeals was the examiner's rejection on the basis of double patenting (i.e. Petitioner's inclusion of a roller-like device on issued patent number 4,262,727.)

Appeal was then taken to the United States Court of Appeals for the Federal Circuit. The latter Court held that the

appeal of Petitioner should have addressed both issues and did not review the appeal on the merits.

REASONS FOR GRANTING THE WRIT

I

THE COMMISSIONER OF PATENTS (AS TO THE SUBJECT CASE) IS ERRONEOUSLY UTILIZING APPEARANCE (AS OPPOSED TO A STRUCTURAL STANDARD) OR SOLELY A FUNCTIONAL STANDARD AS A BASIS FOR REJECTING AN APPLICATION FOR A PATENT FOR AN INVENTION BEFORE THE UNITED STATES PATENT OFFICE PURSUANT TO THE PROVISIONS OF 35 UNITED STATES CODE SECTIONS 102 AND 103.

On October 15, 1981, Petitioner filed an application for a patent on a tire mounting tool, said application being designated serial number 247,281 by the United States Patent Office. The subject application was filed as a continuation in part of applicant's Patent Application serial number 110,556 filed on January 8, 1980 (which was subsequently abandoned), which latter patent application was a division of serial

number 2,030, being filed on January 8, 1979. The latter patent application matured into patent number 4,262,727 entitled "AUTOMATIC TIRE MOUNTING AND DEMOUNTING MACHINE ROLLER". This latter patent is not at issue herein.

The Commissioner of Patents rejected Appellant's application serial number 247,281 and Petitioner filed an appeal with the Patent Office Board of Patent Appeals, and the latter Board upheld the examiner in rejecting Appellant's application. A request for reconsideration was filed by the Appellant before the Board of Patent Appeals, and the Board of Patent Appeals affirmed its decision in denying Appellant's request for reconsideration. The Patent Office Board of Appeals upheld the examiner on the questions of non-obviousness (i.e. Applicant's invention not constituting an inventive step over the prior art under the

parameters of 35 U.S.C. Section 103). Another aspect addressed by the Patent Office Board of Patent Appeals was the examiner's rejection on the basis of double patenting (i.e. Petitioner's inclusion of a roller-like device on issued patent number 4,262,727).

Appeal was then taken to the United States Court of Appeals for the Federal Circuit. The latter Court held that the appeal of Petitioner should have addressed both issues and did not review the appeal on the merits.

Petitioner has advanced this writ as a basis and part of departure from the last decision.

The claims that were submitted to the Patent Office pursuant to the application of Petitioner are set forth in Exhibit A hereto, while the reference patents relied upon by the examiner are set forth in the

following discussion. (See also App. C)

With specific reference to invention involved herein, the subject invention relates to tools used for semiautomatically mounting a tire on a fixed metallic rim in which a revolving roller is used on the mounting end of the tool to facilitate the mounting process. As noted in the Claims, the roller comprising Petitioner's invention comprises a multiple diameter and variable shaped member installed on the mounting end of tire mounting apparatus. The inventive aspect of the subject invention is thus centered mainly on a roller mounted on a tool with such roller being a multiple diameter member which facilitates the tire mounting procedure.

It is the contention of the Appellant that such tire mounting tool roller structure is not anticipated by the prior art, and is a new and useful device. First, the

device has been tested with success and Petitioner is not aware of any comparable tools utilized in this endeavor to alleviate the prevalent problem of tire damage in the tire mounting process. These latter aspects lend additional support for the non-obviousness requirement pursuant to 35 U.S.C. Section 103. Indeed, the relative performance of such a mounting tool roller can help alleviate substantial tire damage problems existent in this area and minimize the manual effort to use the tool, and these aspects should be considered in this appeal. Moreover, it is the position of the Petitioner that the prior art does not render the Appellant's invention non-obvious. A detailed discussion of the prior art will not be made at this juncture, however, certain aspects of the prior art references must be emphasized.

(1) Schultz (3,209,860)

It is the contention of the Petitioner that the Schultz patent is only distantly related to the subject device. Schultz shows a tire mounting tool which is basically comprised of a longitudinal bar member upon end of which is mounted a triple roller system and wherein one of such rollers is mounted on a generally vertical axis (as seen from the perspective where the tool is usually employed). The other two rollers are mounted frontally on a concentric axis which is generally perpendicular to the vertical axis of the first roller. The differences between the Schultz disclosure and the subject application herein are substantial and significant. First, the Petitioner's roller combines all the functions of the three rollers in the Schultz patent. Petitioner's roller serves to both hold down and push radially outward-

ly the tire bead in the mounting function, while impressing the tire bead into the rim. Attention is addressed to the drawings in the subject application, which teach that Petitioner's tool utilizes one roller (with its variable diameters and concommitant convex and concave surface) to accomplish the task of three rollers in Schultz. Specifically, the roller of Petitioner serves to hold down the leading edge of the tire during the mounting process, while the surface of Petitioner's roller serves to push the tire bead radially outwardly.

2. Thompson Patent (U.S. 4,107,830)

The Thompson patent discloses a variable (radii) surfaced roller pin (pastry flattener) which appears to have multiple circumferential surfaces which decrease (or increase) in diameter in a uniformly declining or inclining rate. As noted,

the surface of the roller pin in Thompson is described as convex with different diameters, but the diameters (more technically the radii) are not centered at two distinct points as the subject invention teaches (with variable radial features forming the outer convex surface on the upper part hereof).

(3) Sevastakis Patent (U.S. 4,180,172)

The Sevastakis patent discloses the use of a pinch roller used in casting or forming wherein the roller is multiple diametric, but it does not disclose the use of a direct radii generated from different points as in the subject device. The different diameters or circumferential roller surfaces in Sevastakis do not merge as in the subject device and are structured for different functional purposes as compared to Petitioner's invention.

(4) Weaver Patent (2,569,789)

Weaver discloses the use of a roller for a tire mounting device which could be interpreted as being convex, although it does not show the multiple radial surface, or multiple faceted face of the roller in the subject device. Weaver does not appear to describe his roller as convex.

(5) Eggert Patent (2,097,971)

Eggert discloses a multidiameter roller which is used for manufacturing film. This latter reference does not disclose the functional use of a tire mounting roller which has multiple purposes by reason of the variable diameter, which would anticipate the subject device under the parameters of 35 U.S.C. 102, nor does such device alone or in combination with others serve as a proper obviousness disqualification pursuant to 35 U.S.C. 103.

Examination of the references cited by the examiner, as used in conjunction

with Rainey, reveal the following. First, Schultz (3,029,860) does not show a roller which is similar functionally and structurally to the subject device. It appears that Schultz is cited to show the roller structure, and while Schultz does indeed show a roller mounted eccentrically, Schultz's roller is in fact a combination of the rollers- compared to the one roller in the subject device. Therefore, Schultz's roller function must be performed by two rollers, while the Appellant's roller performs the entire function of two. One roller in Schultz performs a function to hold down the tire bead, while the other roller functions to left of the bead of the tire over the rim. Therefore, in Schultz, two rollers (as opposed to one in the subject device) are required to manipulate and mount the tires.

Finally, it is stressed, in particular

that neither Weaver nor Schultz teach the use of a roller impinging surface which discloses a variable convexity as used in Appellant's invention. While Weaver and Schultz disclose a generic prototype, neither disclose the value of a dual roller surface to help facilitate the tire mounting process. In this respect, a tire mounting roller with such double convexity improves the bead installation substantially. Secondly, the rollers in Sevastakis and Thompson apply to unrelated art, however, irrespective of such unrelated feature, none of the rollers show the double radius feature as generated from a common point, with the lower surface radius extending radially further inwardly than the upper radius, with the radially outer extreme surface functioning as the breaking point between these respective radius surfaces. The claims herein indicate these differences.

Petitioner contends that the effectiveness of these features reveals it was not obvious to one skilled in the art.

In this latter respect, the subject roller of Petitioner with its attendant economy in operation, with the singular roller structure saving wear on tires, overcomes the non-obviousness requirement. (See, for instance, APPLICATION OF SCHUTT, 41 CCPA 781; 210 F2d 293). Additionally, the subject device accomplishes this purpose, and the claims herein reflect this difference of a roller that serves as a singular roller which minimizes tire bead damage, as well as mounting the tire more efficiently. No prior art reference reflects this, along or in combination.

Moreover, if the contention is accepted that the step is obvious, then a reverse question (in a retrospective sense) may be asked, i.e., why was not such a

single roller system employed heretofore to accomplish the mounting function with the efficacy of the subject roller? Petitioner maintains that indeed there is invention within the scope of 35 U.S.C. 103 because of this structural and operational aspect.

It has been long held that the discovery of the cause of a problem is the act that leads to an apparatus that solves such problem may lead to patentable invention even though old elements are combined into the claimed apparatus. Thus, in the case of In Re Peehs (612 F2d 1287, 204 U.S. PQ 835) the former Court of Customs and Patent Appeals stated, in part, as follows:

> "Where an applicant contends that the discovery of the source of a problem would have been unobvious to one of ordinary skill in the pertinent art at the time the claimed invention was made, it is incumbent upon the PTO to explain its reasons if it disagrees.

> A mere conclusionary statement that the source of a problem would have been discovered is inadequate. As this court explained in In Re Sponnoble, 56 CCPA 823, 832, 405 F2d 578, 585, 160 USPQ 237, 243: 'a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the subject matter as a whole which should always be considered in determining the obviousness of an invention under 35 USC 103.' The discovery that certain parts of a process or device are useless is not necessarily evidence of invention. If applicant relies on unexpected superiority or disadvantage over the prior art as evidence of unobviousness, the burden is on him to show it."

Moreover, the mere simplicity of the invention will not necessarily negate patentability. In Diamond Rubber Co. v. Consolidated Rubber Tire Co.; 22 U.S. 428; 55 LEd. 527; 31 S. Ct. 444, the United States Supreme Court held in part as follows:

> "It possesses such amount of change from the prior art as to have received the approval of the Patent Office, and is entitled to the presumption of invention which attaches to a patent. Its simplicity should not blind us as

> to its character. Many things, and the patent law abounds in illustrations, seem obvious after they have been done, and 'in the light of the accomplished results' it is often a matter of wonder how they so long 'eluded the search of the discoverer and set at defiance the speculations of inventive genius"... Knowledge, after the event is always easy, and problems once solved, present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world has always ready at hand and easy to be seen by merely skillful attention. But the law has other tests of the invention than subtle conjectures of what may have been and yet was not. In regards a change as evidence of novelty, the acceptance and utility of change as a further evidence, even as demonstration. And it recognizes degrees of change, dividing invention into primary and secondary..."

Applying the foregoing principles to this case, it was Petitioner's contention in the prosecution of this action that the tire mounting roller, with its multiple radially drawn circumference, had solved the problem of tire gouging during the tire

mounting or demounting process. While the appearance of the Petitioner's roller, albeit simplistic in appearance, was indeed so structured so as to accomplish these projected ends. Petitioner contends that an appearnce test as applied to such a roller does not do justice, from the viewpoint of 35 U.S. Section 103, and using a test of outward appearance overlooked completely the Petitioner's invention. This latter inventive aspect was drawn to utilization of a rather specific peripherally drain surface, using a precise radial pattern to form such a roller purpose. The end product, while appearing outwardly to resemble some prior art rollers, as discussed above, was unique in this specific radial pattern of formation. Thus, a patent should have been issued accordingly.

II

THE COMMISSIONER OF PATENTS HAS NO AUTHORITY TO REJECT CLAIMS SET FORTH IN A PATENT APPLICATION UNDER THE THEORY OR DOCTRINE OF A PROVISIONAL "OBVIOUSNESS-TYPE" DOUBLE PATENTING CONCEPT, AS SUCH A REJECTION IS BASED ON SUPPOSITION OR CONJECTURE.

It has been held that the Patent Office Board of Appeals cannot sustain a rejection, as based on the theory of provisional "double-patenting" under an obviousness type rejection approach (In re Mott; 529 F2d 1291; 190 USPQ 536; CCPA, 1976). It appears that the rationale for such restraint stems from the fact that such a rejection is indeed provisional and based on conjecture.

In this case, although the Patent Office Board of Appeals made reference to the Petitioner's patent (number 4,403,640), which is the parent patent to the patent application in question herein, it did note that the claims of such parent patent are

are not identical to those claims in question in this matter. Moreover, the Patent Office Board of Patent Appeals correctly stated that the obviousness type double patenting rejection is a doctrine established by judicial decree in order to prevent "prolongation of monopoly by prohibiting claims in a second patent not patentably distinct from claims in a first patent (In Re Vogel; 422 F2d 438; 164 USPQ 619; CCPA; 1970). However, in applying this doctrine to the instant matter, the Patent Office Board of Appeals appeared to have overlooked the long-standing view of the courts as to the non-obviousness requirement.

As stated, Judge Leonard Hand in Traitel Marble Co. vs. V.T. Hungerford Brass & Co., 18 F2d 66, 2 C.C.A.; 1927:

> "Very slight structural changes may be enough to support a patent, when they presuppose a use not discoverable without inventive imagination. We are to judge such devices, not

be the mere innovation in their former material, but by the purpose which dictated them and discovered their function."

The modern standard is set forth in 35 U.S.C. 103 which provides as follows:

"Conditions for patentability; non-obvious subject matter. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of 35 U.S. section 102, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

It is the contention of the Petitioner that the double patenting rejection was improper because of two reasons: First, the

invention disclosure used as a reference was that of the Petitioner (See Traitel Marble Co., supra). Secondly, the rejection was a conditional rejection based on the supposition of issue of another patent. These aspects are interconnected with the non-obviousness rejection under 35 U.S.C. Section 103, as addressed above, and any rejection on the basis of double patenting under this conditional status would appear to be improper, even as stated by the Patent Office Board of Appeals in its decision (See Exhibit C hereto).

CONCLUSION

In conclusion, it is urged that the United States Supreme Court review this matter in light of the two questions presented in order to clarify the proper test under the Patentability Standard of

35 U.S.C. Section 103, and to further rectify the question of double patenting under the umbrella of conditional rejections with an applicant being the inventor of the prior references.

Respectfully submitted,

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APPENDIX A

Claim 1

A tire mounting roller rotatably mounted on a tire mounting tool for mounting a flexible tire on a tire rim comprising:

(a) a base cylindrical member rotatably mounted on said tool for rotation about a vertical longitudinal axis, said roller having an upper and lower portion, said upper portion having a larger diameter than the lower portion and wherein said upper portion is convex on its peripheral circumferential surface, with the convexity of such convex surface being defined by two separate radii emanating from a common point within the upper portion of said roller.

Claim 2

A tire mounting roller rotatably

affixed to a tire mounting tool for mounting a flexible tire on a tire rim, and wherein said roller has a longitudinally extending vertical central axis about which said roller is symmetrically formed and about which vertical axis said roller is rotatably mounted for free rotation relative to said tire mounting tool, said roller comprising:

(a) a lower portion said lower portion being shaped in the form of an inverted truncated cone with the upper part of said lower portion having a larger diameter than the lower part thereof;

(b) an upper portion with said upper portion on said roller having respectively an upper and lower part with the lower part of said upper portion being fixed adjacent to the upper part of said lower portion

of said roller in a flush, concentric manner, and wherein said upper portion has a circumferential peripheral lip which is convex, and wherein such convex lip is defined on its external surface by three separate radii each generated from a center point which is within the upper portion on said roller.

Claim 3

A tire mounting roller rotatably mounted on a tire mounting tool for mounting a flexible tire on a tire rim comprising:

(a) a base cylindrical member rotatably mounted on said tool for rotation about a vertical longitudinal axis, said roller having an upper and lower portion, said upper portion having a larger diameter than the lower portion and wherein said upper

portion is convex on its peripheral circumferential surface, with such convexity defined by two separate radii, one being uppermost on said circumferential surface and one being lowermost on said circumferential surface, with the uppermost radii being generated from a point which is common to the point from which the lowermost radii is drawn, and wherein the lowermost radii extends further radially inwardly on said upper portion than does the uppermost radii.

Claim 4

A tire mounting roller rotatably affixed to a tire mounting tool for mounting a flexible tire on a tire rim, and wherein said roller has a longitudinally extending vertical central axis about which said roller is symmetrically con-

structed and about which vertical axis said roller is rotatably mounted for free rotation relative to said tire mounting tool, said roller comprsing:

(a) a lower portion said lower portion being shaped in the form of an inverted truncated cone with the upper part of said lower portion having a larger diameter than the lower part thereof;

(b) an upper portion, said upper portion on said roller having respectively an upper and lower surface with the lower surface of said upper portion being adjacent to the upper part of said lower portion on said roller and wherein said upper portion has a circumferential surface which is formed by two distinct surfaces formed by two distinct radii of generation, with the uppermost of

such surfaces being shorter in circumferential length, as viewed in cross section, than the lowermost such surface.

Claim 5

A tire mounting roller rotatably mounted on a tire mounting tool for mounting a flexible tire on a tire rim comprising:

(a) a base cylindrical roller member rotatably mounted on said tool for rotation about a vertical longitudinal axis, said base cylindrical member having an upper and lower portion, said upper portion having a larger diameter than the lower portion, and wherein said upper portion is convex on its peripheral circumferential surface, with the convexity of such convex surface being defined by two separate radii emanating from

a common point within the upper portion of said roller, with the upper radius being of a smaller radius than the lowest radius of curvature.

Claim 6

A tire mounting roller rotatably mounted on a tire mounting tool for mounting a flexible tire on a tire rim comprising:

(a) a base cylindrical member rotatably mounted on said tool for rotation about a vertical longitudinal axis, said roller having an upper and lower portion, said upper portion having a larger diameter than the lower portion and wherein said upper portion is convex on its peripheral circumferential surface with such convexity defined, as viewed in cross section, by two separate radii emanating from a common point within

the upper portion of said roller, and wherein such convex lip is defined on its external surface by two separate radii each generated from a center point which is within the upper portion on said roller.

APPENDIX B

Note: This opinion has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent. The decision will appear in tables published periodically.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

87-1545

IN RE RICHARD SCHIFFERLY

DECIDED: February 9,1988

Before RICH, Circuit Judge, BALDWIN, Senior Circuit Judge and SMITH, Circuit Judge

RICH, Circuit Judge.

DECISION

This appeal is from the decision of the U. S. Patent and Trademark Office Board Trademark Office Board of Patent Appeals and

Interferences (board) affirming the examiner's rejection of claims 1-7, all the claims in application serial No. 247,281, filed October 15, 1981, and also entering a new rejection of claims 1-7 under 37 CFR 1.196(b). We affirm.

OPINION

The examiner, in his final rejection of September 1, 1983, rejected claim 1 "under 35 U.S.C. 112, first paragraph" as not supported by the written description of the specification with respect to the claim limitation that the convex surface of the upper portion of the roller is defined by "two separate radii emanating from a common point." Appellant has never responded to or traversed this rejection which was affirmed by the board (see 37 CFR 1.196(a) and that rejection must therefore be affirmed.

The board, acting under the authority

conferred upon it by 37 CFR 1.196(b), repeated or reinstated a rejection prematurely made by the examiner, and rejected all claims (1-7) "as being unpatentable over claims 1 through 3 of appellant's prior U.S. Patent No. 4,403,640" by reason of double patenting, obviousness type. We do not examine the merits of that rejection because we need not. It stands uncontested by appellant on this appeal and therefore must be affirmed. Appellant's brief in this court simply ignores it. We note also the board's observation that on the appeal to the board "appellant did not choose to argue [the examiner's] rejection" for double patenting.

Because of these failures to contest outstanidng rejections covering all claims in appellant's application, the Commissioner moves to dismiss the appeal or for summary affirmance. We choose the latter option

The motion is contained in the Commissioner's brief (p. 2) filed December 24, 1987. Appellant has made no response thereto and has filed no reply brief. As our predecessor, the Court of Customs and Patent Appeals, held in In re Loehr, 500 F.2d 1390, 1394, 183 USPQ 56, 59 (CCPA 1974), appellant's failure to brief and argue the merits of a new rejection by the board under Rule 1.196(b) is an abandonment thereof. Such an uncontested rejection must be affirmed. That disposes of this appeal. With one outstanding uncontested rejection, it would be pointless to consider the obviousness issue which is all that appellant's brief discusses.

APPENDIX C

Art Unit 323 MAILED Paper No. 21
FEB 27 1987
Appeal PAT & T.M. OFFICE LLB
No. 599-05 BOARD OF PATENT APPEALS
AND INTERFERENCES
ON BRIEF

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte Richard E. Schifferly

- - -

Application for Patent filed October 15, 1981, Serial No. 247,281, a Continuation-in-Part of Serial No. 110,556 filed January 8, 1980, now abandoned, which is a Division of Serial No. 2,030 filed January 8, 1979, now U.S. Patent No. 4,262,727. Automatic Tire Mounting and Demounting Machine Roller.

George R. Royer for appellant

Primary Examiner - James G. Smith

C-13

Before Pendegrass, Cohen, and Lyddane, Examiners-in-Chief.

Lyddane, Examiner-in-Chief.

This is a decision on an appeal from the final rejection of claims 1 through 7, which are all the claims in the application. No claim is allowed.[1]

The subject matter on appeal relates to a tire mounting roller mounted on a tire mounting tool which is used to mount a flexible tire on a tire rim. Claims 1, 2, and 7 are illustrative to the subject matter on on appeal and read as follows:

1. A tire mounting roller rotatably mounted on a tire mounting tool for mounting a flexible tire on a tire rim comprising:

---

[1]The copy of the claims on appeal provided by appellant on pages 1 through 4 of the brief is correct except for claims 2, 3, 5, and 6 as noted by the examiner, and a correct copy of which has been provided on pages 1 through 3of the answer.

(a) a base cylindrical member rotatably mounted on said tool for rotation abou a vertical longitudinal axis, said roller having an upper and lower portion, said upper portion having a larger diameter than the lower portion and wherein said upper portion is convex on its peripheral cirdumferential [sic, circumferential] surface, with the convexity of such convex surface being defined by two separate radii emanating from a common point within the upper portion of said roller.

2. A tire mounting roller rotatably affixed to a tire mounting tool for mounting a flexible tire on a tire rim, and wherein said roller has a longitudinally extending vertical central axis about which said roller is symmetrically formed and about which vertical axis said roller is rotatably mounted for free rotation relative to said tire mounting tool, said roller comprising:

(a) a lower portion said lower portion being shaped in the form of an inverted truncated cone with the upper part of said lower portion having a larger diameter than the lower part thereof;

(b) an upper portion with said upper portion on said roller having respectively an upper and lower part with the lower part of said upper portion being fixed adjacent to the upper part of said lower portion of said roller in a flush, concentric manner, and wherein said upper portion has a circumferential peripheral lip which is convex, and wherein such convex lip is defined on its external surface by two separate radii each generated from a center

point which is within the upper portion on said roller.

7. A tire mounting roller rotatably affixed to a tire mounting tool for mounting a flexible tire on a tire rim, and wherein said roller has a longitudinally extending vertical central axis about which said roller is symmetrically constructed and about which vertical axis said roller is rotatably mounted for free rotation relative to said tire mounting tool, said roller comprising:

(a) a lower portion said lower portion being shaped in the form of an inverted truncated cone with the upper part of said lower portion having a larger diameter than the lower part thereof;

(b) an upper portion, said upper portion on said roller having respectively an upper and lower surface, with the lower surface of said upper portion being adjacent to the upper part of said lower portion on said roller and wherein said upper portion has a circumferential surface which, when viewed in cross section, has a surface which is defined by two separate radii generated from separate points within the upper portion, and wherein the external surface has a curvature different above and below the tangential radially outer extremity of such upper part.

The references of record relied upon by the examiner as evidence of obviousness under 35 USC 103 are as follows:

The references of record relied upon by the examiner as evidence of obviousness under 35 USC 103 are as follows:

Eggert et al. (Eggert)	2,097,971	Nov. 2, 1937
Weaver	2,569,789	Oct. 2, 1951
Ehrhardt	2,621,652	Dec.16, 1952
Schultz et al. (Schultz)	3,029,860	Apr.17, 1962

The following reference has been relied upon by this Board in a rejection under the provisions of 37 CFR 1.196(b):

Schifferly	4,403,640	Sep.13, 1983

Claims 1, 3, 5, and 6 stand rejected under 35 USC 103 as being unpatentable over Weaver or Schultz in view of Eggert or Ehrhardt. It is the examiner's position that it would have been obvious to modify the tire changing structure of either the patent to Weaver or the patent to Schultz by using a roller with a double convex, shaped by two different

radii, as taught by either of the patents to Eggert or Ehrhardt.

Claims 2, 4, and 7 stand rejected under 35 USC 103 as being unpatentable over Weaver in view of Eggert or Ehrhardt, for the reason stated above.

Claims 1 through 7 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of appellant's then copending application Serial No. 104,741 in view of Eggert or Ehrhardt. It is the examiner's position that at the time the invention was made it would have been obvious to use a roller with separate radii as taught by the patents to Eggert or Ehrhardt.

The appellant argues with respect to the patent to Schultz that the invention defined in the claims on appeal combines all of the functions of the

three rollers disclosed in the patent to Schultz. Appellant also provides a force diagram on page 7 of the brief for the roller of the patent to Schultz and the roller defined in the claims on appeal, and alleges that the roller of the patent to Schultz does not yield the vector component "R" (shown in appellant's force diagram) to push the tire bead gently ahead and outwardly to eliminate tire bead damage.

With respect to the patent to Weaver, appellant urges that the roller as disclosed therein could be interpreted as being convex, but does not show multiple radial surfaces.

Appellant concludes his arguments by stressing that neither of the patents to Weaver or Schultz teaches the use of a Roller impinging surface which discloses a variable convexity as is defined in

the claims on appeal. Appellant also contends that the roller as defined in the claims on appeal provides a single roller structure having an economy of operation which saves wear on tires thereby overcoming the nonobviousness requirement and that the claims on appeal reflect the difference of a roller that serves as a single roller minimizing tire bead damage as well as mounting the tire more efficiently, with minimal damage and effort. It is urged that no prior art reference teaches this, alone or in combination with any other references.

In reaching our decision which follows, we have given careful consideration to appellant's specification and claims, to the prior art of record and to the respective positions advanced by the appellant in the brief and by the examiner

in the answer. Upon consideration of the evidence of record, it is our opinion that the rejection of claims 1 through 7 under 35 USC 103 is proper, and we shall, therefore, sustain the examiner's rejection.

With respect to appellant's argument that the roller of the instant invention combines all functions of the three rollers disclosed in the patent to Schultz, it is not apparent to us that a single roller as defined in the claims on appeal can or does perform all of the functions of the rollers shown in Figures 1 through 3 of the patent to Schultz. In fact, there is no disclosure in appellant's specification or claims that a single roller as defined in the claims on appeal could perform the tire mounting function by itself. The only disclosure

of how a roller configured as defined in the claims on appeal can be used to mount a tire is shown in the apparatus of Figures 1 and 10 of the drawings of the instant application. The tire mounting device as illustrated requires two such rollers in order to mount the tire on the rim. Therefore, it is not seen how the roller structure as defined in the claims on appeal combines all of the functions of the three rollers in the Schultz patent.

With respect to the vector diagrams provided by appellant in the brief, appellant's source of information necessary to construct these diagrams is not apparent to us. Furthermore, the roller 19, 23 of the patent to Schultz as shown in Figure 3 does not appear to be all that different in configuration from that of the roller

shown in Figures 11 and 12 of appellant's drawings.

We cannot agree with appellant's argument that neither the patent to Weaver or Schultz teach the use of a roller surface having a variable convexity as defined in the claims on appeal. It is our opinion that both the patent to Schultz and the patent to Weaver show a roller member substantially as claimed which includes an upper portion having a convex outer surface. Whether the convexity of the outer convex surface is defined by two separate radii emanating from separate points or not is regarded as a matter of choice. Where a change solves no stated problem, we consider it to be a mere matter of choice and therefore obvious. See In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

Appellant's further arguments that the "singular roller structure" provides economy and operation and saves wear and tear on tires, minimizing tire bead damage in mounting the tire more efficiently, are not directed to any limitations defined in the claims on appeal. As noted above, it does not appear that a single roller as defined in the claims on appeal provides the tire mounting functions as argued, rather, it appears that at least two such rollers are required along with the mounting structure shown in Figures 1 and 10 of appellant's drawings. Therefore, the arguments are not commensurate with the scope of the claims.

Accordingly, we shall sustain the examiner's rejection of claims 1 through 7 under 35 USC 103.

With respect to the examiners re-

jection of claims 1 through 7 under the judicially created doctrine of obviousness-type double patenting, we note that at the time of the final rejection, there was no indication that any of the claims in the application upon which the obviousness-type double patenting rejection was based had been allowed. However, subsequent to the final rejection, U.S. Patent No. 4,403,640 issued, which was based on U.S. application Serial No. 282,728 which was a continuation-in-part of Serial No. 104, 741. It appears to us that at the time of the final rejection only a provisional "obviousness-type" double patenting rejection could have been made, and we are not empowered with the authority to sustain a provisional rejection. See In re Mott, 539, F.2d 1291, 190 USPQ 536 (CCPA 1976). We do note, however, that appellant did not choose to argue this

rejection in the brief.

Under the provisions of 37 CFR 1.196 (b), we make the following new rejection of claims 1 through 7 under the judicially created doctrine of obviousness-type double patenting:

Claims 1 through 7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 3 of appellant's prior U.S. Patent No. 4,403,640. Although the claims are not identical, they are not patentably distinct from each other because the roller structure per se, as defined in the claims on appeal, does not patentably distinguish over the roller structure defined in the claims in U.S. Patent No. 4,403,640, and as apparent from appellant's arguments in the brief, the functional differences between prior

art roller structure and that defined in the claims on appeal reside in the claimed combination.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of monopoly by prohibiting claims in a second patent not patentably distinct from claims in a first patent. See In re Vogel, 422 F2d 438, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome a rejection on this ground. See MPEP 804.02 and 1490.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date

hereof (37 CFR 1.197).

With respect to the new rejection under 37 CFR 1.196(b), should appellant elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire one month from the date of this decision. In the event appellant elects this alternate option, in order to preserve the right to seek review under 35 USC 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

37 CFR 1.136(a) does not apply.

In summary, the decision of the examiner rejecting claims 1 through 7 under 35 USC 103 is affirmed, and while the decision of the examiner rejecting claims 1 through 7 under the judicially created doctrine of obviousness-type double patenting cannot be affirmed, a new rejection has been introduced under the authority of 37 CFR 1.196(b).

AFFIRMED
37 CFR 1.196(b)

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